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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT: FORD, GARRETT N.

DOCKET NO.: 122142.00009

SERIAL NO.: 10/755,984

FILED: 01/13/2004

EXAMINER: NGUYEN, SON T.

ART UNIT: 3643

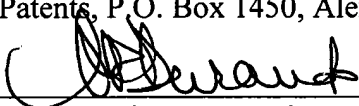
TITLE: HORSE BOOT WITH DUAL TONGUE ENTRY

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Antonio R. Durando  
6902 N. Table Mountain Road.  
Tucson, AZ 85718-1331

CERTIFICATE OF MAILING

I hereby certify that on this 15<sup>th</sup> day of June, 2006, this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Antonio R. Durando

TRANSMITTAL OF BRIEF ON APPEAL

Dear Sir:

Pursuant to the provisions of 37 C.F.R. 41.37, the appellant is hereby submitting three (3) copies of a Brief on Appeal in the above-captioned patent application.

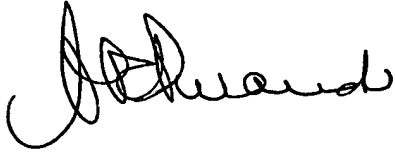
The \$250.00 appeal brief filing fee required by 37 C.F.R. 1.17(c) has already been paid in this case in a previous appeal filed on 10/26/05. The case was re-opened for prosecution by the Examiner. Therefore, pursuant to MPEP Sect. 1207.04, the previously paid appeal brief fee can be applied to this new appeal and no fee is believed to be due at this time.

06/20/2006 WNSFW1-00000042-041935-10755984

01-FC-2402-250.00-BA

Please charge any other cost associated with the filing of this Brief on Appeal to our Deposit  
Account No. 04-1935.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'A. Durando', with a large, stylized initial 'A'.

Antonio R. Durando  
Reg. No. 28,409

(520) 243-3383 Telephone  
(520) 577-6988 Fax



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Antonio R. Durando

TO THE COMMISSIONER FOR PATENTS

**APPELLANT'S BRIEF ON APPEAL**

**(i) Real Party in Interest**

The real party in interest is EasyCare, Inc., the assignee of the entire interest in the above-identified patent application.

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**(ii) Related Appeals and Interferences**

No other appeals or interferences are known to the appellant, to the appellant's legal representative, to EasyCare, Inc., or to assignees, which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal

**(iii) Status of Claims**

The case was filed with 19 claims, of which Claims 1 and 18 are independent claims. In reply to the first office action, the appellant amended both independent Claims 1 and 18, and added new dependent Claims 20 and 21. The Examiner issued a final rejection of all claims on the basis of new prior art. The appellant appealed the rejection of Claims 1-21.

Upon review of the case on appeal, the Examiner withdrew the case from appeal, performed a third search, and issued a final rejection of all claims on new grounds. The appellant filed a response with an amendment to Claim 1 designed to overcome the new art and requested reconsideration of the finality of the rejection. By advisory action, the Examiner maintained the finality of the rejection and did not enter the new amendment for appeal. The appellant then filed a Petition to the Director under 37 C.F.R. 1.181 for review of the Examiner's decision with regard to the finality of the last office action. The Petition is currently pending. Concurrently, the appellant filed this appeal.

Claims 1-21 stand rejected. In view of the Examiner's refusal to enter the amendment to Claim 1, the appellant believes that Claims 1-17 and 21 are not in conditions for allowance

as previously presented. Accordingly, the appellant only appeals the rejection of Claims 18-20 at this time.

**(iv) Status of Amendments**

An amendment to Claim 1 was submitted with the response filed subsequent to the final rejection issued after the Examiner withdrew the case from appeal. The amendment was not entered in view of the finality of the action. The propriety of the Examiner's refusal to enter the amendment is under review in the pending Petition to the Director.

**(v) Summary of Claimed Subject Matter**

The invention is an article of footwear 10 for a hoofed animal (Fig. 1, page 6, lines 2-4). The article comprises a support 12 designed to bear against the hoof of the animal and against the ground (page 6, lines 5-8). The article further comprises an enclosure 14 designed to enclose at least part of the hoof of the animal, and the enclosure 14 includes a wall 16,18 on the support 12 (page 6, line 9 to page 7, line 4). The enclosure 14 additionally includes a pair of tongues 24,32 (Figs. 2 and 3) each of which is of one piece with the support 12 and each of which has a major portion which is pivotable relative to the wall 16,18 (page 7, lines 11-14 and page 8, lines 10-14). The front tongue 24 is attached directly to the support 12, while the rear tongue 32 is attached directly to the wall 16,18 of the enclosure 14 (Figs. 1-4, 8). With reference to Claims 18-20, the claims on appeal, the rear tongue 32 is movable relative to the wall 16,18 and is attached to the wall by means of at least one band 36a,36b of elastic material (Fig. 3, page 8, lines 10-12 and page 8, line 18 to page 9, line 2).

**(vi) Grounds of Rejection to be Reviewed on Appeal**

Claims 18-20 stand rejected under 35 USC 102(b) as being anticipated by Adam, U.S.

Patent No. 840,892.

**(vii) Argument**

For convenience of the reader, Figures 1-12 of the appellant's drawings are attached Exhibit A.

The reference cited by the Examiner as grounds of rejection is attached in the Evidence

Appendix item of the brief.

**Ground of Rejection – Anticipation**

**Claims 18-20**

The Examiner rejected Claims 18, 19 and 20 under 35 U.S.C. 102(b) as anticipated by Adam (U.S. Patent No. 840,892). This patent describes a horse shoe with a one-piece front tongue having a major portion pivotable with respect to the wall enclosing the boot support, and further with a one-piece rear tongue that is attached to and pivotable with respect to the support of the horse shoe. The rear tongue 6 is attached to the wall of the boot by means of straps 8,9 that are tightened to fit and secured by buckles 14. The wall of the boot is provided with gores 11, apparently for allowing tightening of the wall around the hoof.

Independent Claim 18 of the present invention recites, in part, "at least one band of elastic material connected to said tongue and to said wall." It is respectfully submitted that Adam does not disclose any such elastic structure. Neither one of the straps 8 and 9, which the

Examiner referenced as structures corresponding to the appellant's claimed elastic bands 36, are described as elastic. In fact, the straps 8,9 are clearly not elastic because they are intended to be used with a buckle to strap the boot in place. Elasticity is not an inherent property of straps, and usually it is an undesirable feature. Thus, in view of the lack of any express disclosure of elasticity, it is respectfully submitted that Claim 18 is not anticipated by the Adam reference.

In view of the foregoing, the applicant submits that Claim 18, as presented on appeal, is not anticipated by Adam and recites patentable subject matter. Accordingly, the appellant believes that the Examiner erred in rejecting these claims and urges the Board to so hold.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Antonio R. Durando', with a stylized, cursive script.

Antonio R. Durando  
Reg. No. 28,409

(520) 770-8760 Telephone  
(520) 770-2236 Fax

**(viii) Claims Appendix**

The claims involved in this appeal read as follows:

18. An article of footwear for a hoofed animal comprising:  
  
a support designed to bear against a hoof of the animal and against the ground; and  
  
an enclosure designed to enclose at least part of the hoof of the animal, said enclosure including a wall on said support, a tongue on said support movable relative to said wall, and at least one band of elastic material connected to said tongue and to said wall.
19. The article of claim 18, wherein said tongue has a pair of opposed edges and said one band joins one of said edges to said wall, said enclosure including an additional band of elastic material joining the other of said edges to said wall.
20. The article of claim 18, wherein said tongue and said at least one band are made from different pieces of material.

**(ix) Evidence Appendix**

Reference Cited by the Examiner as Grounds for Rejection

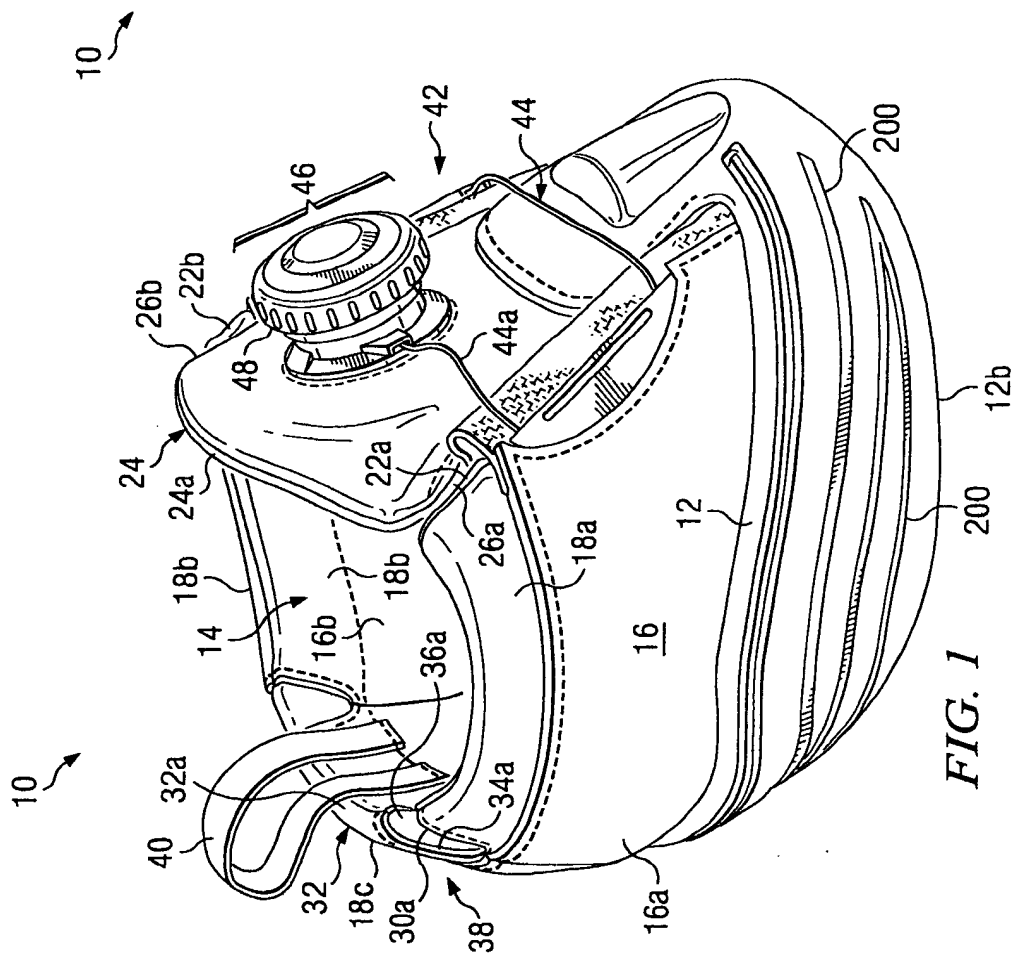
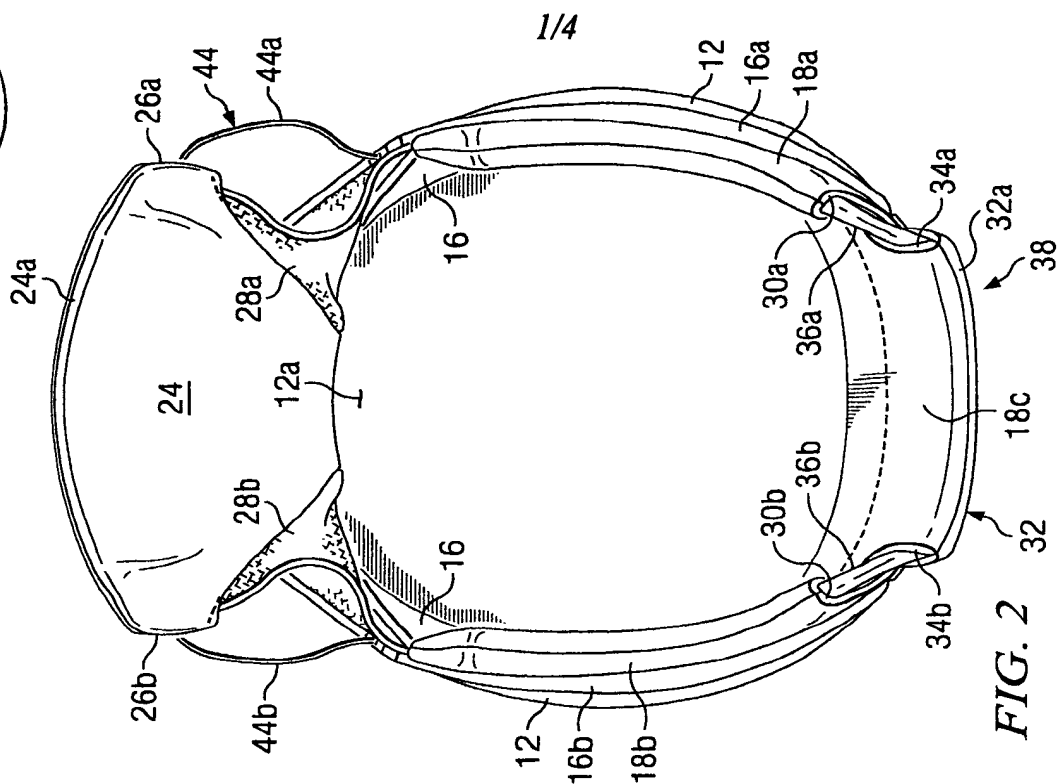
U.S. Patent No. 840,892 (Adam)

**(x) Related Proceedings Appendix**

Not applicable.

## EXHIBIT A

Figures 1-8 of the above-identified application.



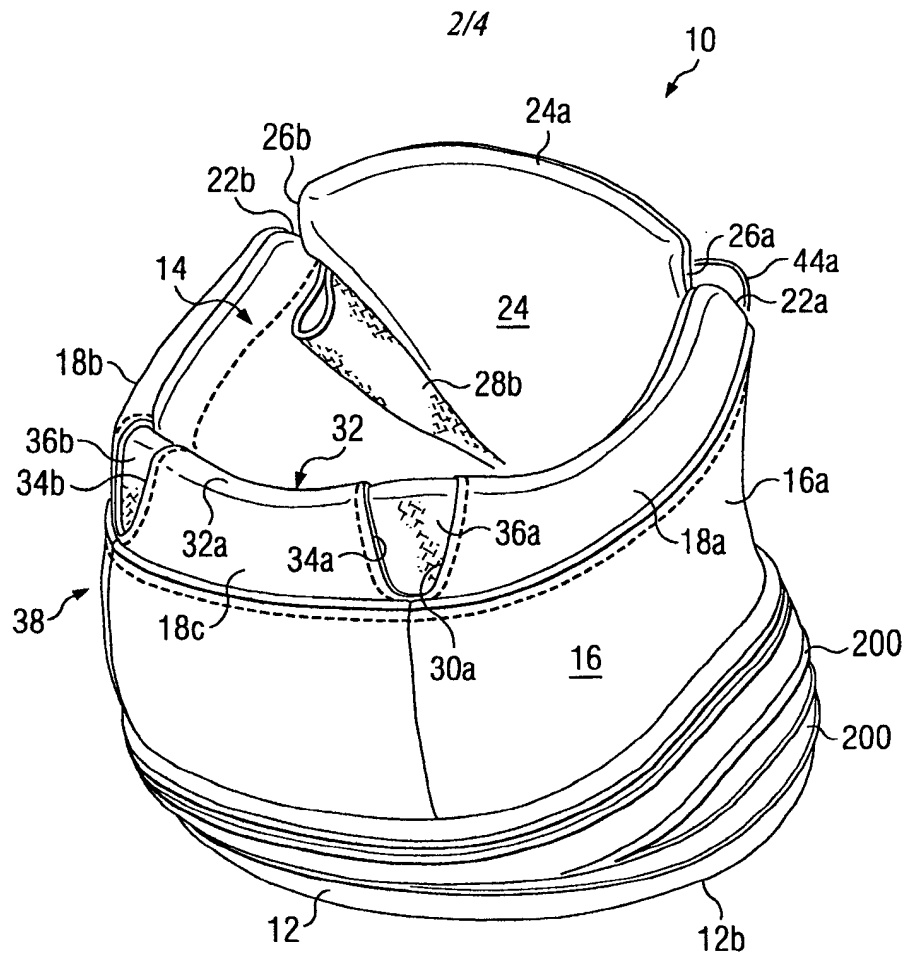


FIG. 3

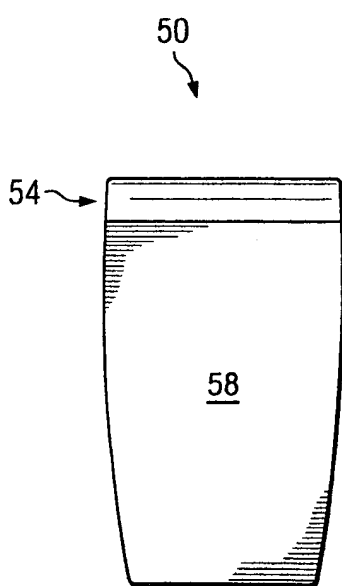


FIG. 5

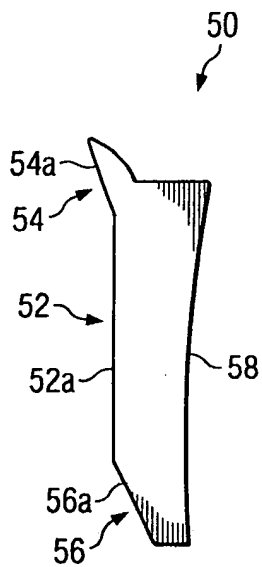


FIG. 6

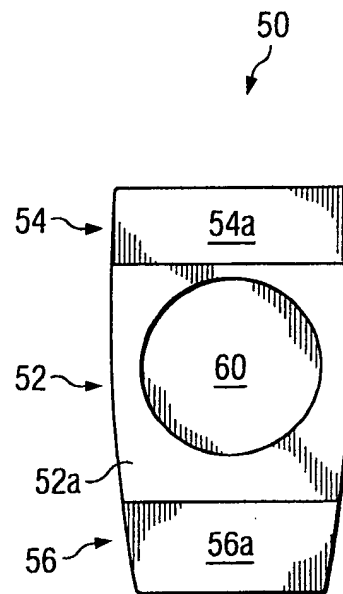
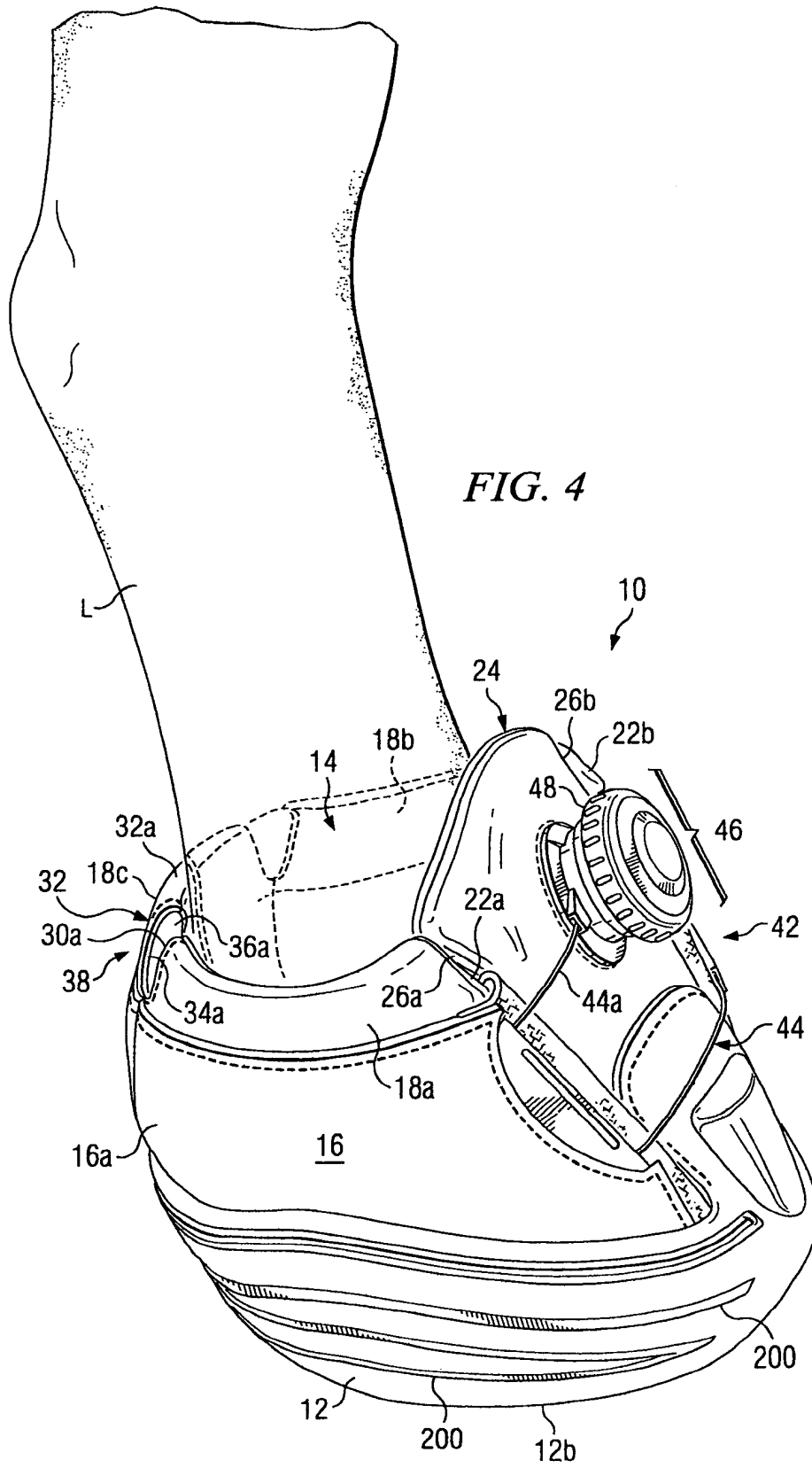


FIG. 7

FIG. 4



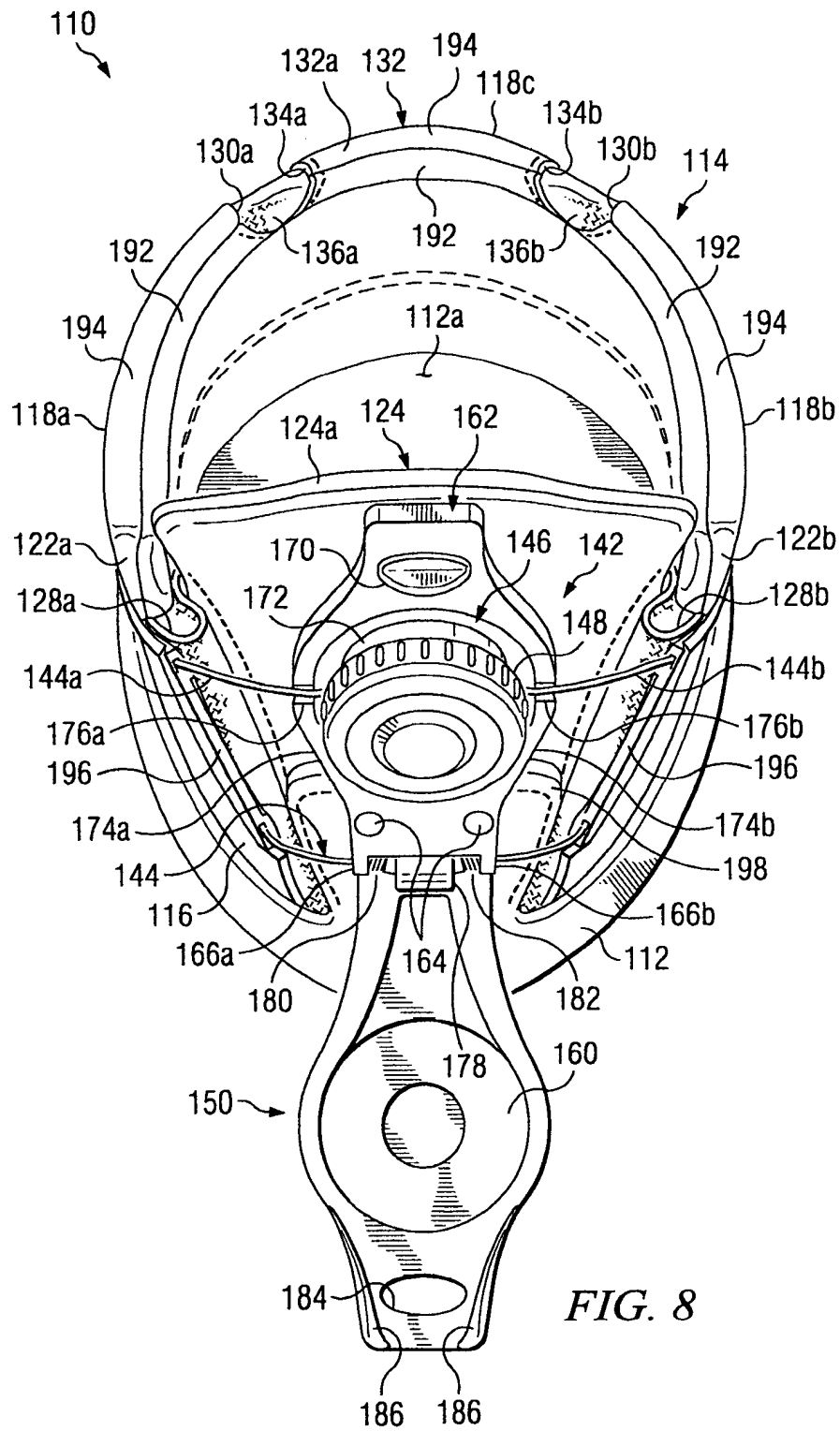


FIG. 8